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Paper No. 6

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In re Application of
Waller, et al.
Application No. 09/992,239
Filed: November 6, 2001
For: INFORMATION RETRIEVAL AND
DISPLAY

COPY MAILED

AUG 09 2002

OFFICE OF PETITIONS

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(b)

This is in response to the April 12, 2002 petition under 37 C.F.R. §1.47(b).

BACKGROUND

This application was filed on November 6, 2001. However, the application lacked a declaration signed by the inventor as required by 35 U.S.C. §25, 35 U.S.C. §115, 37 C.F.R. §1.63, and 37 C.F.R. §1.68. Accordingly, the Office of Initial Patent Examination (hereinafter "OIPE") mailed a notice to file missing parts of nonprovisional application (hereinafter "notice") to the address of record on December 6, 2001. The notice requested a signed declaration and set a two month period for replying.

Applicants responded with this petition, which the office received on April 12, 2002. The petition included a request for a two month extension of time, which with the certificate of mailing dated April 4, 2002, was timely.

THE RULE

37 C.F.R. §1.47

- (a) ...
- (b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

ANALYSIS

A review of the rule above shows that a grantable petition under 37 C.F.R. §1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) proof of irreparable damage.¹

With regard to inventor Ward, Petitioner has failed to satisfy requirement one (1) above.

Proof that the non-signing inventors cannot be reached or refuse to sign the oath or declaration.

Before a refusal to sign can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, the address of the nonsigning inventor's attorney.² No showing of delivery of the application papers to inventor Ward has been made. Rather, Petitioner specifically states that

"I did not request a duplicate set of documents...for sending to inventor Ward because inventor Ward had been named as an inventor on two other patent applications in which documents had been sent to him and not returned. I concluded from this that inventor Ward had either moved away without providing a forwarding address or was unwilling to sign."³

No indication was made of any attempts to locate co-inventor Ward, not to mention any attempt to deliver the application papers to him.

Before signing a declaration stating that one has read and understood the contents of the application, it is necessary that one be actually presented with a copy of the declaration to review. Accordingly, the inventor Ward has not refused to sign after being given an opportunity to review the application within the meaning of 37 C.F.R. §1.47.

Rule 47 status has, however, been established as to co-inventor Waller.

Therefore, *this petition is dismissed.*

Petitioner is given TWO MONTHS from the mailing date of this decision to respond, correcting the above-noted deficiency. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. §1.136(a).

¹ See 37 C.F.R. §1.47 "Filing when an inventor refuses to sign or cannot be reached."

² M.P.E.P. §409.03(d) "Proof of Unavailability or Refusal"

³ Declaration of Christine Sheppard

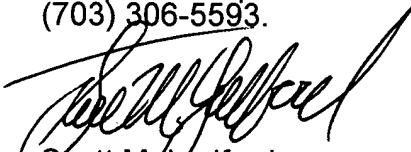
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